Attorney Docket No. 38481-8532US

Express Mail Label EV 335524307 US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RE APPLICATION OF: Mark Robins	EXAMINER: James A. Reagan
APPLICATION NO.: 09/540,391	ART UNIT: 3621
FILED: March 31, 2000	CONF. NO: 2190
FOR: FEATURE CENTRIC RELEASE MANAGER METHOD AND SYSTEM	

Appeal Brief Transmittal

RECEIVED

JUL 1 1 2003

GROUP 3600

Mail Stop Appeal Brief-Patents
Commissioner for Patents
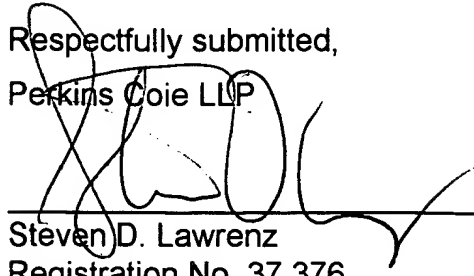P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

    Further to the Notice of Appeal submitted May 14, 2003, enclosed herewith are the following:

☒   Applicant's Appeal Brief in triplicate.

☐   Petition for   -Month Extension of Time.

☒   Fee (37 C.F.R. § 1.17(c)): ☐ Small Entity: $160.00
                                       ☒ Large Entity: $320.00

      ☒   A check for $$320.00 covering the above fee is enclosed.

      ☐   Please charge the above fee(s) to Deposit Account No. 50-0665. This paper is provided in triplicate.

      ☒   Please charge any underpayment for timely consideration of this paper to Deposit Account No. 50-0665.

☒   Applicant petitions for an Extension of Time if necessary for timely filing of this Brief.

Respectfully submitted,
Perkins Coie LLP

Steven D. Lawrenz
Registration No. 37,376

Date: 7/3/03

Correspondence Address:
Customer No. 25096
Perkins Coie LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 583-8888

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: MARK ROBINS	EXAMINER: JAMES A. REAGAN
APPLICATION NO.: 09/540,391	ART UNIT: 3621
FILED: MARCH 31, 2000	CONF. NO: 2190
FOR: **FEATURE CENTRIC RELEASE MANAGER METHOD AND SYSTEM**	

Appeal Brief

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant hereby submits this brief in triplicate in support of the pending appeal from a final decision of the Examiner mailed December 18, 2002, in the above captioned case. A Notice of Appeal was timely filed on May 14, 2003. Appellant respectfully requests consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the above captioned patent application.

I. REAL PARTY IN INTEREST

The rights of the inventor in this application have been assigned, via the assignment recorded at reel 010969, frame 0022, to Siebel Systems, Inc., a corporation formed under the laws of the state of Delaware having a place of business at 2207 Bridgepointe Parkway, San Mateo, California 94404, who is the owner of all right, title, and interest in the above identified patent application.

II. RELATED APPEALS AND INTERFERENCES

Appellant's legal representative and the real party in interest are unaware of any appeal or interference which will directly affect, be directly affected by, or have a bearing on the Board's decision in the present appeal.

III. STATUS OF CLAIMS

Claims 15-17 and 23-28 are pending in the application.[1] Claims 1-14 and 18-22 were canceled during prosecution, and claims 15-17 and 23-28 were added during prosecution.

The Examiner has rejected claims 15, 16, 26, and 27 under 35 U.S.C. § 103(a) over User's Guide for Microsoft Project ("Project User's Guide") and Using Microsoft Project 4 ("Using Project"); rejected claims 23 and 24 under 35 U.S.C. § 103(a) over Project User's Guide, Using Project, and Eisner, The Essentials of Project and Systems Engineering Management ("Eisner"); rejected claims 17 and 28 under 35 U.S.C. § 103(a) over Project User's Guide, Using Project, and Kroenke, Database Processing: Fundamentals, Design, and Implementation ("Kroenke"); and rejected claim 25 under 35 U.S.C. § 103(a) over Project User's Guide, Using Project, Eisner, and Kroenke.

Appellant appeals the rejection of each of the pending claims .

IV. STATUS OF AMENDMENTS

Appellant has filed no amendments subsequent to the final rejection.

V. SUMMARY OF DISCLOSURE

Appellant has created a system for managing and monitoring the development of a product, such as a software product release. In some embodiments, appellant's techniques solicit from users desired features for the product, such as users who are marketing personnel or prospective purchasers of the product. For each of a

---

[1] The Appendix to this brief contains a copy of the claims on appeal.

number of features chosen for inclusion in the product, appellant's techniques solicit and store one or more tasks that must be completed by developers in order to incorporate the feature into the product. These tasks are said to be linked to the product feature. In some embodiments, appellant's techniques further group the solicited tasks into task groups.

VI.   REJECTIONS

As described above, appellant's techniques provide for tracking the progress of a product development process by linking tasks to the product's features. In that regard, claim 15 recites "defining a plurality of tasks, wherein each of said tasks is associated with one of said product features, the plurality of tasks being grouped into task types; linking each of the plurality of tasks with one of the plurality of product features"; claim 23 recites "an engineer task list user interface by which the user enters and tracks information related to tasks being completed to implement the product features entered in the feature list interface, wherein the tasks correspond to one of the product features"; and claim 26 recites "defining, for each feature, a plurality of tasks necessary to implement the feature; linking each task with its corresponding feature". Each of the other pending claims is dependent from one of these three independent claims.

In the non-final office action mailed on October 9, 2002, the Examiner rejected all of the pending claims over combinations all containing two references describing a Microsoft Project software package: Project User's Guide and Using Project. In appellant's view, these two references make clear the following: (1) Microsoft Project can be used to track a project by tracking progress on a number of tasks. Such tasks may be grouped together under a summary task that corresponds to a larger process made up of the tasks grouped under it. For example, the following tasks may be grouped under a "Finance Phase" summary task: "Create Business Plan," "Present to Current Investors," "Meet With Bankers," etc. (2) Microsoft Project imposes no control over the text entered for summary tasks, and is therefore unable to prevent a user from entering text for summary tasks that, rather than referring to a

larger process made up of the tasks grouped under them, instead refers to product features to which the tasks grouped under them relate.

In the October 9 office action, while explicitly acknowledging that the cited two Project references fail to disclose linking tasks to product features as recited, the Examiner indicated that it would have been obvious to one of ordinary skill in the art at the time the application was filed to exploit the flexibility of Microsoft Project described in (2) above to enter text for summary tasks that refers to product features to which the tasks grouped under the summary tasks relate. The Examiner included examples of such summary tasks whose text refers to product features to which the tasks grouped under the summary tasks relate. Appellant assumes that those examples were prepared by the Examiner as part of preparing this office action, as no other source was cited. The Examiner failed to identify any motivation for this modification, however.

In the final office action mailed December 18, 2002, the Examiner cited and discussed three new references not cited by appellant in an IDS: U.S. Patent No. 6,347,258 to Hsu et al. ("Hsu"); U.S. Patent No. 5,036,472 to Buckley et al. ("Buckley"), and Florida Technology Development Corporation – Integrated Product and Process Design Print Quality Analyzer, Microview Systems ("Florida Technology"). In order to justify the finality of the December 18 office action, the Examiner clearly indicated that he was maintaining the rejections of the October 9 office action without altering their basis, and using the newly-cited references only to support his assertion in the October 9 office action that Microsoft Project is flexible enough to permit a user to enter product features in place of summary tasks.

VII.   ISSUES

The following issue is presented for review:

Have claims 15-17 and 23-25 been improperly rejected under 35 U.S.C. § 103(a) over combinations of references each including Using Project and Project User's Guide?

VIII.   GROUPING OF CLAIMS

Claims 15 and 16 stand or fall together.

Claim 17 stands or falls alone.

Claims 23-25 stand or fall together.

Claims 26 and 27 stand or fall together.

Claim 28 stands or falls alone.

IX.   ARGUMENTS

As indicated above, appellant readily concedes that Microsoft Project is flexible enough to permit a user to enter product features in place of summary tasks. Accordingly, appellant concurs that it was possible to modify the two references describing Microsoft Project as proposed by the Examiner.

However, to make a prima facie case of unpatentability under 35 U.S.C. § 103(a), it is insufficient to merely demonstrate that it is possible to modify the cited references in accordance with the rejected claims. Rather, the Examiner must identify a source of motivation that would have caused one of ordinary skill in the art to perform the necessary modification. MPEP § 706.02(j).

As mentioned above, the Examiner did not identify any such source of motivation in the October 9 office action. The Examiner also failed to identify any such source of motivation in the prior art rejections of the December 18 office action. Because the Examiner designated the December 18 office action as final, the Examiner is unable to use the three newly-cited references to provide new evidence of such motivation.   MPEP § 2144.03(D) makes it very clear that, in the absence of amendments to all of the rejected claims, new references may be added in final office actions only to support earlier assertions by the Examiner of what was common knowledge, and not to rely on any additional teachings of the new references. Because the Examiner made the December 18 office action final, the Examiner may not rely on any of the three new references to show motivation to modify.

Even were the Examiner able to rely on the three new references to show a motivation to modify, however, these references would not succeed in showing such

a motivation, as there is no indication among these references that any sort of connection was made between product features and tasks before the making of appellant's invention. As for the Florida Technology reference discussed by the Examiner, while the portion of this reference provided by the Examiner shows both (1) a "House of Quality" grid listing features generated while designing a product and (2) a Gantt chart produced with Microsoft Project showing the product's development schedule, including ranges of times for performing each of a number of tasks making up the development project, nothing in the provided portion makes any attempt to link, combine, or otherwise relate these two separate bodies of information.

Although ambiguous, the Examiner appears to assert that, in Florida Technology, both the House of Quality grid and the Gantt chart were produced using Microsoft Project. (pp. 5-6: "For purposes of project planning, the team used Microsoft Project, as shown in the enclosure. Specifically, MicroView used project not only to build the 'House of Quality' metric standardization table, but also to develop a concept-screening matrix. Furthermore, MicroView used Microsoft project to determine a planned timeline for developing and building the system, as shown in the enclosure.") Appellant can find nothing in the provided portion of Florida Technology to support this assertion, and the different styles of these two documents suggest to appellant that they were generated using different software packages. The Examiner has failed to respond to appellant's invitation in his response to the December 18 office action to more adequately substantiate this position.

Even if the Examiner was successful in establishing that both documents were produced using Microsoft Project, however, this would not complete a prima facie case of unpatentability under 35 U.S.C. § 103(a), as there remains no indication that product features contained in the House of Quality grid are in any way linked to or otherwise related to the tasks shown in the Gantt chart.

Because the Examiner has failed to cite a reference describing the linking of product features to development tasks as recited by the pending claims, and because the Examiner has failed to advance any evidence—let alone adequate

evidence—showing that one of ordinary skill in the art would, at the time of filing, would have been motivated to modify the cited references in this manner, the present rejections of the pending claims fail to establish a prima facie case of unpatentability under 35 U.S.C. § 103(a).

Additionally, even if the Examiner succeeded at making a prima facie case of unpatentability under 35 U.S.C. § 103(a), appellant submits that this prima facie case would ultimately be rebutted, for at least the following reasons: (1) The references describing Microsoft Project, by describing entering task groups where the Examiner proposes entering features, teach away from the modification proposed by the Examiner. (2) The modification proposed by the Examiner destroys important utility of Microsoft Project, as it prevents the attribution of tasks to summary tasks as described by the cited references. As one example, in the Examiner's proposed listing of tasks under product features, because the "Send replaced processor to parts supply" task is listed under the "1600 MHz Pentium processor" feature and the "Send replaced stick to parts supply" task is listed under the "Ram – 256 Mbytes" feature, these two tasks cannot be listed under a "Return unneeded parts to parts supply" summary task as intended by the references describing Microsoft Project. (3) Assuming a user does replace summary tasks with features in accordance with the modification proposed by the Examiner, the project no longer contains task types, as required at least by claim 15.

Additionally, claim 15 recites "tracking the status of each feature." The fact that the Examiner has similarly failed to identify a prior art reference showing this act or a source of motivation to add it lends further support to the impropriety of the present rejection of claims 15-17.

Additionally, claim 23 recites "a product feature list user interface by which a user enters desired feature of the product to be released." While the rejection of claim 23 asserts that this feature is discussed in the rejection of claim 15, it is not, lending further support to the impropriety of the present rejection of claims 23-28.

X.   SUMMARY

Each of the pending claims has been improperly rejected over combinations of references including Using Project and Project User's Guide. Accordingly, Appellant respectfully requests that the Board reverse the rejection of these claims.

Respectfully submitted,
Perkins Coie LLP

Date: 7/3/03

Steven D. Lawrenz
Registration No. 37,376

Correspondence Address:
Perkins Coie LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 583-8888
FAX: (206) 583-8500

APPENDIX
CLAIMS ON APPEAL

15.   A method for managing a release of a product, comprising:

describing the product in terms of a plurality of product features;

entering a description of each of said product features, wherein said description comprises an instantiation of a feature list graphical user interface;

defining a plurality of tasks, wherein each of said tasks is associated with one of said product features, the plurality of tasks being grouped into task types;

linking each of the plurality of tasks with one of the plurality of product features;

entering a task progress development as an instantiation of a task-type graphical user interface, wherein the task-type graphical user interface is selected from a plurality of task-type graphical user interfaces, each corresponding to one of the task types; and

tracking a status of each product feature via the instantiated task-type graphical user interfaces.

16.   The method of claim 15, further comprising:

linking all of the graphical user interfaces to one another via the features.

17.   The method of claim 16, further comprising:

storing the feature descriptions, task definitions and task progress developments in a relational database; and

wherein linking comprises:

> linking each task definition and related task progress developments to their corresponding one of the plurality of product features through the use of relational database keys.

23.   A system for managing a release of a product, comprising:

a product feature list user interface by which a user enters desired features of the product to be released;

an engineer task list user interface by which the user enters and tracks information related to tasks being completed to implement the product features entered in the feature list user interface, wherein the tasks correspond to one of the product features;

a quality assurance user interface by which the user manages and tracks both quality assurance test plans and tests that are executed against the test plans and designed to ensure the functionality of the desired product features; and

a technical documents list user interface by which the user enters and tracks information related to documents being developed to describe the desired product features,

wherein all parameters entered by the user into the engineer task list user interface, the quality assurance user interface and the technical documents list user interface are each defined in terms of a particular one of the product features entered into the feature list user interface.

24.   The system of claim 23, wherein all parameters entered by the user into the engineer task list user interface, the quality assurance user interface and the technical documents list user interface are each linked to a particular one of the product features entered into the feature list user interface.

25.   The system of claim 23, further comprising:

a relational database operable to store data entered into the interfaces, and further operable to filter the data based on the product features.

26.   A method for managing a release of a product, the method comprising:

describing the product in terms of desired features of the product;

defining, for each feature, a plurality of tasks necessary to implement the feature;

linking each task with its corresponding feature; and

entering data associated with a selected one of the plurality of tasks into a graphical user interface associated with the selected task.

27.   The method of claim 26, further comprising:

selecting a graphical user interface displaying data associated with a task based on the feature associated with the task.

28.   The method of claim 26, further comprising:

storing the features, tasks and data in a relational database; and

linking the tasks and their associated data with their associated features by assigning a key to each feature, task and datum.